

**Applicant: Falone et al.**  
**Application No.: 09/978,130**

### **REMARKS**

Claims 34-52 are currently pending in this application. By the foregoing amendment, claims 34, 35, and 41-47 have been amended.

Independent claims 34, 41, and 46 have been amended to further clarify the meaning of the claim term "coextensive". Applicants submit that the term coextensive means that the reinforcement layer extends generally throughout the insert. As requested by the Examiner, the claims have been amended to clarify Applicants usage of the term "coextensive". To clarify Applicants' use of the term coextensive, Applicants have amended the independent claims to define an insert body having an outer perimeter and to define that the reinforcement layer extends throughout the entire area of the insert body as bounded by the outer perimeter. The independent claims were amended to cancel the recitation of the elastomer layers being free of voids as required by the Examiner.

Claims 35, 44, and 47 were amended to recite that the material of the reinforcement layer generally prevents elongation. Those of ordinary skill in the art will appreciate from Applicants' disclosure that substantial elongation of the reinforcement layer would require that the high tensile fibers be stretched; which cannot substantially occur during normal use by a person.

Claim 42 was amended to recite that the fiberglass material is formed by individual strips. This claim is supported for each of the reasons mentioned in connection with the prior version of claim 41. Claims 43 and 45 have been amended

**Applicant: Falone et al.**  
**Application No.: 09/978,130**

to change dependency only. Claim 45 has been amended to change "cloth" to "reinforcement" as required by the Examiner.

No new matter is added to the application by this amendment.

### **INTERVIEW**

A telephone interview between Examiner John Kavanaugh and Ruy Garcia-Zamor took place on August 9, 2004. During the interview it became apparent that Examiner Kavanaugh was interpreting "coextensive" in a broad sense, rather than the narrower sense used by Applicants. Applicants have amended the independent claims as suggested by the Examiner to make it clearer that Applicants are using the narrower definition of "coextensive".

Applicants thank Examiner Kavanaugh for the many courtesies extended during the interview.

### **CLAIM REJECTIONS - 35 U.S.C. § 112**

Claims 34-52 have been rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement due to the recitation that the elastomer layers are "substantially free of voids". Applicant has cancelled the claim language identified by the Examiner.

**Applicant: Falone et al.**  
**Application No.: 09/978,130**

Claim 45 has been rejected under 35 U.S.C. § 1112, second paragraph, as indefinite for reciting "cloth layer". Claim 45 has been amended to instead recite "reinforcement layer".

Applicants submit that claims 34-52 now fully comply with Section 112. Applicants respectfully request that the Examiner reconsider and withdraw the Section 112 rejections.

#### **CLAIM REJECTIONS - 35 U.S.C. § 112**

Claims 34-37, 41, and 46-49 have been rejected under 35 U.S.C. § 103 as being anticipated by U.S. Patent 5,463,824 ("Barna.>").

Applicants' invention is directed to a shoe insert formed of a thermoset elastomer material including first and second elastomer layers. The first and second elastomer layers are preferably thermoset silicone elastomer layers. A reinforcement layer consisting of a single layer of aramid, fiberglass, or high tensile strength fibrous material is disposed between the first and second elastomer layers. The reinforcement layer is generally coextensive with the first and second thermoset layers so that the reinforcement layer extends generally throughout the entire area of the shoe insert as bounded by the outer perimeter of the shoe insert.

Barna is directed to an arch support system that positions a small stretch resisting member 16 under part of the arch of the foot. There is no disclosure, teaching, or suggestion of providing a reinforcement layer that is coextensive with

**Applicant: Falone et al.**  
**Application No.: 09/978,130**

covering and underlying elastomer layers as recited in Applicants' claims. Additionally, Barna uses an upper surface portion 12 that is formed by a polyurethane foam. Polyurethane foam has voids therein. Furthermore, Barna specifically states that:

[T]he top cover, or upper surface portion, 12, is composed of a substantially consistent thickness sheet of polyurethane foam. This may be approximately 1/16 inch thick and may be of a material known in the industry as Poron, which has been widely accepted and proven in the shoe-insole industry. The open-cell structure of this material allows it to breathe and dissipate moisture and may be treated with anti-bacterial and anti-odor agents. Specification, Column 2, lines 60-67.

Accordingly, there is no disclosure, teaching, or suggestion of using first and second elastomer layers that are substantially free of voids. In fact, Barna teaches away from the use of elastomer layers without voids. Applicants respectfully submit that new claims 34-37, 41, and 46-49 are patentable over the prior art of record.

Applicants respectfully request that the examiner reconsider and withdraw the outstanding Section 103 rejection.

#### INVITATION

If any additional matters need to be addressed to place this application in condition for allowance, the Examiner is respectfully invited to contact the undersigned, by telephone, at the Examiner's convenience.

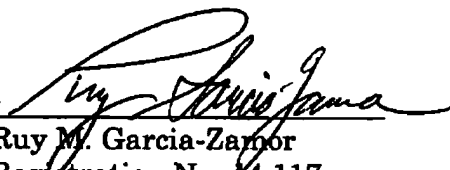
**Applicant: Falone et al.**  
**Application No.: 09/978,130**

**CONCLUSION**

In view of the foregoing Amendment and Remarks, Applicants respectfully submit that the present application, including claims 34-52, is in condition for allowance and a notice to that effect is respectfully solicited.

Respectfully submitted,

Falone et al.

By   
Ruy M. Garcia-Zamor  
Registration No. 44,117  
(215) 568-6400

Volpe and Koenig, P.C.  
United Plaza, Suite 1600  
30 South 17<sup>th</sup> Street  
Philadelphia, PA 19103  
RGZ/kr